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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 09/996,467 | 11/26/2001 | Bohdan Zajac | Prod Sol P-311 | 2698 |
| 7590 02/26/2004 CARGILL & ASSOCIATES 56 Macomb Place Mt. Clemens, MI 48043-5636 | | | EXAMINER SHOSHO, CALLIE E | |
| | | | ART UNIT 1714 | PAPER NUMBER |

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/996,467 | Applicant(s) ZAJAC, BOHDAN | |
| | Examiner Callie E. Shosho | Art Unit 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21 and 15-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 17 and 19 is/are allowed.
- 6) ☒ Claim(s) 15, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections and objections except for those described below are overcome by applicants' amendment filed 11/26/03.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (U.S. 5,750,269) in view of Roberts (U.S. 5,453,459).

The rejection is adequately set forth in paragraph 5 of the office action mailed 7/21/03 and is incorporated here by reference.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swidler (U.S. 5,719,221) in view of Roberts (U.S. 5,453,459).

The rejection is adequately set forth in paragraph 6 of the office action mailed 7/21/03 and is incorporated here by reference.

Response to Arguments

5. Applicants' arguments filed 11/26/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that:

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(a) There is no disclosure in either Park or Roberts of caustic as required in the present claims.

(b) Park does not disclose combination of polymers as presently claimed.

(c) Park requires the use of hot water which is unnecessary in the present invention.

(d) There is no disclosure in Swidler of caustic as required in the present claims.

(e) Both Swidler and Roberts require the use of alkaline aqueous solution to remove coating which is direct contrast to the present claims which require only water.

With respect argument (a), it is agreed that there is no disclosure in Park of caustic which is why Park is used in combination with Roberts.

Park discloses ammonia neutralizer. Roberts, which is drawn to temporary protective coating, as is Roberts, disclose the use of neutralizer including alkali metal hydroxide in addition to ammonia. Applicants argue that Roberts do not disclose caustic as presently claimed. However, col.col.4, lines 15-17 and 19 of Roberts disclose the use of alkali metal hydroxide to adjust the pH of the coating to 7 to 10.5. Given that alkali metals include sodium and potassium, it is clear that Roberts disclose the use of caustic, i.e. sodium hydroxide or potassium hydroxide, as presently claimed.

In light of the disclosure of Roberts of the equivalence and interchangeability of sodium or potassium hydroxide with ammonia as disclosed by Park, it therefore would have been obvious to one of ordinary skill in the art to use sodium hydroxide or potassium hydroxide in the coating of Park, and thereby arrive at the claimed invention.

With respect to argument (b), it is agreed that Park does not disclose combination of acrylic resins which is why Park is only applied against present claims 20 and 21 which only require the use of one acrylic resin.

With respect to argument (c), it is noted that the present claims only require that the composition is removed from the article by washing with water. Thus, the claims are open to the use of hot water, cold water, etc. There is nothing in the present claims which excludes the water used to remove the coating from the article from being hot.

With respect to argument (d), it is agreed that there is no disclosure in Swidler of caustic which is why Swidler is used in combination with Roberts.

Swidler disclose use of material such as ammonia and ethylamine to adjust the pH of the composition. Roberts, which is drawn to surface protective coating for automobiles, as is Swidler, disclose the use of alkali metal hydroxide in addition to ammonia and ethylamine to control the pH of the coating.

In light of the disclosure of Roberts of the equivalence and interchangeability of sodium or potassium hydroxide with ammonia or ethylamine as disclosed by Swidler, it therefore would have been obvious to one of ordinary skill in the art to use sodium hydroxide or potassium hydroxide in the coating of Swidler, and thereby arrive at the claimed invention.

With respect to argument (e), it is noted that Swidler disclose removing the coating with pH basic water wash. Present claim 15 requires the coating is removed from the article by rinsing or washing with water.

Given that Swidler discloses removing the coating with pH basic water wash, it is clear that Swidler meets the requirements of present claim 15. That is, there is nothing in the present claims that excludes the use of ingredients in addition to water when removing the coating from the article.

With respect to Roberts, while it is agreed that Roberts requires the use of alkaline solution to remove the coating, note that Roberts is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of sodium or potassium hydroxide pH controller in temporary protective coatings, and in combination with the primary reference, discloses the presently claimed invention.

Allowable Subject Matter

6. Claims 16-17 and 19 are allowable over the "closest" prior art for the following reasons:

Swidler (U.S. 5,719,221) discloses a surface protective coating useful for protecting the surface of an automobile from scratches wherein the coating composition comprises 1-10% water-soluble acrylic polymer which is polymerized from (meth)acrylic acid and other monomers, (2) 1-10% pH-neutral acrylic copolymer which is polymerized from monomers comprising (meth)acrylates, (3) 0.2-1% surfactant and/or wetting agent, (4) thickener, and (5)

substantial amount of water wherein the balance of the composition is water. The coating has a pH of 7-9. However, there is no disclosure or suggestion in Swidler of caustic as presently claimed as well as no disclosure of the acid number of the composition as required in each of present claims 16 and 19 as well as no disclosure of the molecular weight of the acrylic resins or viscosity of the composition as further required in present claim 19.

Park (U.S. 5,750,269) discloses water-washable coating composition for temporarily protecting a coating of paint on an article wherein the composition comprises film-forming acrylic resin having weight average molecular weight of 20,000-400,000 and acid number of 23-227. The composition comprises 5-50% solids with the remainder water wherein 10-80% of the solids is acrylic resin. However, there is no disclosure or suggestion of using two acrylic resins or caustic as required in each of present claims 16 and 19 or any disclosure of the pH of the composition. Further, there is no disclosure of viscosity of the composition as further required in present claim 19.

Roberts (U.S. 5,453,459) disclose a temporary protective coating composition for automobiles which comprises caustic such as alkali metal hydroxide, water, and mixture of acrylic acid copolymers. However, there is no disclosure in Roberts of the acid number or pH of the composition as required in present claims 16 and 19 or any disclosure of the molecular weight of either of the acrylic resins or viscosity of the composition as further required in claim 19.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

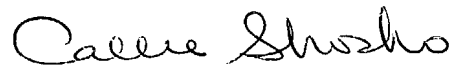
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
2/23/04